

REMARKS

Reconsideration of the above-identified application is respectfully requested in view of the amendments above and the discussion that follows.

Claims 12, 13 and 14 have been cancelled, claims 1, 3, 9 and 17 have been amended, and claims 22 through 31 have been added. Claims 1-11 and 15-31 are in the case and are before the Examiner.

1. The Amendments

Claims 12-14 have been cancelled to clarify the invention. Claims 1, 3, 9 and 17 have been amended pursuant to the Examiner's helpful suggestions and to clarify the invention. Specific support for the length of an encoded polypeptide of an immunogen can be found at least at page 21, in the paragraph between line 6 and 18. The remaining added language of subparagraph (a) (ii) of each of claims 1, 3 and 17 is at least similarly supported.

The word "having", which was asserted to be vague and indefinite because it is allegedly unclear whether it is open or closed, has been changed to "comprising", a word that is clearly "open". *Ex parte Davis and Tuukkanen*, 80 USPQ 448, 450 (Pat. Bd. App. 1948). It is also believed that "having" is recognized by

the courts as being "open" as well. See, *In re Certain Slide Fasteners*, 216 USPQ 907, 915 (U.S. Int'l. Trade Comm'n. 1981). Use of the word "comprising" in this context is also supported at least by the text at lines 6-18 of page 32.

The phrases added to the last lines of each of claims 1 and 3 are generally supported by the claims themselves and complete the concept disclosed in each. Further specific support for the added language can be found at least at page 16, lines 5-20 and page 17, line 13, through page 18, line 13.

Claim 9 has been amended to further clarify the invention. Specific support for the use of thyroglobulin can at least be found at page 19, lines 14-19.

New claims 22-31 have been added to further define the invention. Specific support for the encoded sequences of claims 22-28 and 31 can at least be found at page 21, lines 6-18. Specific support for claim 29 can be found in the claims already on file as well as the above disclosure at page 21, lines 6-18. Specific support for use of a cytomegalovirus immediate-early promoter sequence can at least be found in the paragraph bridging pages 32 and 33.

It is thus seen that no new matter has been added.

2. The Action

All of the claims were rejected over the disclosures of WO 96/34888 of Rittershaus et al. (Rittershaus) in view of Felgner et al. U.S. Patent No. 5,580,859 (Felgner) and further in view of Swenson et al., J. Biol. Chem., 264(24):14318-14326 (Aug. 25, 1989) (Swenson). This basis for rejection cannot be agreed with and is respectfully traversed as discussed below.

The Rittershaus disclosure was the basis for rejection in parental applications Serial No. 08/785,997 and No. 08/788,882, both filed on January 21, 1997. Declarations pursuant to 37 C.F.R. § 1.31 were filed in both of those applications that successfully overcame those rejections. True copies of those Declarations are attached hereto as Exhibits A and B as suggested in the Interview Summary. It is thus believed that this basis for rejection is moot.

It is believed that except two points, each of the points raised in the Interview Summary have been dealt with in the amendments and comments above. The remaining points are discussed below.

In regard to the word "vehicle", the Examiner's attention is invited to the specification at least at page 12, lines 1-5, page 18, lines 2-5, page 35, lines 9-16 and the text

from the paragraph bridging pages 35 and 36 through page 37, line 19. It is thus believed that this basis for objection is also moot.

The Interview Summary noted that the product claims "read on cDNA in mammalian expression vector". Although that statement is broadly correct, it is submitted that not just any cDNA is recited. As such, and in view of the enclosed Exhibits A and B, it is further submitted that the product claims are patentable.

3. New Art

In the time since the mailing of the present Action, an International Search Report for the corresponding PCT application has been received. As is shown on its face, that Report was mailed on January 29, 1999. A copy of that report and the accompanying art are enclosed herewith as Exhibit C. The art that accompanied that report is denominated with the prefix "C". Noted document WO 96/34888 that is already of record is not enclosed. The fee required by 37 C.F.R. § 1.97(c) and 37 C.F.R. § 1.17(p) is enclosed herewith. Also enclosed are a copy of (i) WO 99/20302 by Rittershaus et al. that was published on April 29, 1999; (ii) Hruby, *Seminars in Hematology*,

30(4), Suppl.4 (October 1993) 35-44; and (III) Abbey et al., Biochim. Biophys. Acta, 1003(1989) 20-29 and that have come to the attention of the inventors and are believed to possibly be material. These latter disclosures are denominated with the prefix "D". All of this art is listed on the enclosed Form PTO-1449.

4. Summary

Claims 12-14 have been cancelled. Claims 1, 3, 9 and 17 have been amended pursuant to the Examiner's helpful suggestions. Each of the bases for rejection or objection has been dealt with and overcome or otherwise made moot. Further art that has come to the inventor's attention after the outstanding Action was mailed is enclosed and noted on Form PTO-1449, and the appropriate fee is enclosed.

It is believed that this application is in condition for allowance of all of the claims. An early notice to that effect is earnestly solicited.

No further fee or petition is believed to be necessary. However, should any further fee be needed, please charge our Deposit Account No. 23-0920, and deem this paper to be the required petition.

The Examiner is requested to phone the undersigned should any questions arise that can be dealt with over the phone to expedite this prosecution.

Respectfully submitted,

By 
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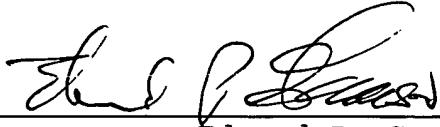
Enclosures

Petition and fee under § 1.17(c)
Exhibits A, B and C
Form 1449
Additional art
Fee under § 1.17(p)

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CERTIFICATE OF MAILING

I hereby certify that this Response, a Petition for a three-month extension of time and fee, Exhibits A-C, Form 1449, additional art and fee under § 1.17(p) are being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on June 17, 1999.


Edward P. Gamson